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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/905,508	08/04/1997	LALEH SHAYESTEH	023070-06772	5513

7590 11/07/2008
TOWNSEND AND TOWNSEND AND CREW
TWO EMBARCADERO CENTER 8TH FLOOR
SAN FRANCISCO, CA 941113834

EXAMINER

HUFF, SHEELA JITENDRA

ART UNIT	PAPER NUMBER
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1643

MAIL DATE	DELIVERY MODE
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11/07/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 08/905,508	Applicant(s) SHAYESTEH ET AL.	
	Examiner Sheela J. Huff	Art Unit 1643	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 June 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 37-39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 37-39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>7/18/05</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

A request for continued examination under 37 CFR 1.114 was filed in this application after appeal to the Board of Patent Appeals and Interferences, but prior to a decision on the appeal. Since this application is eligible for continued examination under 37 CFR 1.114 and the fee set forth in 37 CFR 1.17(e) has been timely paid, the appeal has been withdrawn pursuant to 37 CFR 1.114 and prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on 6/16/08 has been entered.

Claims 37-39 are pending.

The rejection of claims 37 and 38 under 35 USC 103 over Daneshvar in view of Xiao or Skorski is withdrawn in view of applicant's declaration.

Information Disclosure Statement

The IDS filed 7/18/05 has been considered and an initialed copy of the PTO-1449 is enclosed.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

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1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 37 and 38 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Bonjouklian et al US 5378725 in view of Arnold, Genes, Chromosomes and Cancer vol. 16 p. 46-54 (1996) and Volinia et al Genomics vol. 24 p. 472 (1994) and further in view of (in the alternative) Xiao et al, International journal of Oncology vol. 6 p. 405 (1995) or Skorski et al Blood, vol. 86 p. 726 (1995). The reasons for this rejection are of record in the paper mailed 5/10/07.

Applicant argues gene amplification does not necessarily lead to expression and provides Gray II declaration in support of this. While applicant's declaration does support applicant's argument, the argument is not persuasive because as shown in the Bonjouklian et al reference the PI 3-kinase inhibitor is inhibiting the PI 3-kinase enzyme

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(ie the protein). Therefore, absent objective evidence to the contrary it is expected that since the inhibitor is inhibiting the protein, the protein must be expressed.

Claim 39 remains rejected under 35 U.S.C. 103(a) as being unpatentable over Bonjouklian et al US 5378725 in view of Arnold, Genes, Chromosomes and Cancer vol. 16 p. 46-54 (1996) and Volinia et al Genomics vol. 24 p. 472 (1994) and further in view of (in the alternative) Xiao et al, International journal of Oncology vol. 6 p. 405 (1995) or Skorski et al Blood, vol. 86 p. 726 (1995) as applied to claims 37 and 38 above, and further in view of Powis et al International journal of Pharmacology vol 33 p. 17 (1995) . The reasons for this rejection are of record in the paper mailed 5/10/07.

Applicant's arguments have been addressed above.

Claim 39 remains rejected under 35 U.S.C. 103(a) as being unpatentable over Bonjouklian et al US 5378725 in view of Arnold, Genes, Chromosomes and Cancer vol. 16 p. 46-54 (1996) and Volinia et al Genomics vol. 24 p. 472 (1994) and further in view of (in the alternative) Xiao et al, International journal of Oncology vol. 6 p. 405 (1995) or Skorski et al Blood, vol. 86 p. 726 (1995) as applied to claims 37 and 38 above, and further in view of June US 6632789. The reasons for this rejection are of record in the paper mailed 5/10/07.

Applicant's arguments have been addressed above.

Claim 39 remains rejected under 35 U.S.C. 103(a) as being unpatentable over Bonjouklian et al US 5378725 in view of Arnold, Genes, Chromosomes and Cancer vol. 16 p. 46-54 (1996) and Volinia et al Genomics vol. 24 p. 472 (1994) and further in view of (in the alternative) Xiao et al, International journal of Oncology vol. 6 p. 405 (1995) or Skorski et al Blood, vol. 86 p. 726 (1995) as applied to claims 37 and 38 above, and further in view of Lavin et al Experientia Vol. 52 p. 979 (1996). The reasons for this rejection are of record in the paper mailed 5/10/07.

Applicant's arguments have been addressed above.

Conclusion

All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sheela J. Huff whose telephone number is 571-272-0834. The examiner can normally be reached on Tuesday and Thursday from 5:30am to 1:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Larry Helms can be reached on 571-272-0832. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Sheela J Huff/
Primary Examiner
Art Unit 1643

sjh